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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/994,973	11/27/2001	Dean M. Hildebrand	CA920000061US	2852

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IBM CORPORATION
INTELLECTUAL PROPERTY LAW DEPT.
P.O. BOX 218
YORKTOWN HEIGHTS, NY 10598

EXAMINER
PATEL, DHAIRYA A

ART UNIT	PAPER NUMBER
2151	

DATE MAILED: 01/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO 90C (Rev 10/03)

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on _19 March 2004_.

2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) _1-37_ is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) _1-37_ is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☒ All b) ☐ Some * c) ☐ None of:

1. ☒ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. _____.

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _3/19/04_.

4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____ .

DETAILED ACTION

1. Application # 09/994,973 was filed on 11/27/2001. Claims 1-37 are subject to

examination.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 19-26,33,35-36 are rejected under 35 U.S.C. 101 because the claimed

invention is directed to non-statutory subject matter.

As per claim 19, the claim recites "A computer program comprising..", failing to

recite any hardware necessary to render the claims tangible.

For the purpose of this office action, it is assumed that the platform is

incorporated into the appropriate hardware.

As per claims 20-26, the claims recite "The program of claim 19..." failing to

recite any hardware necessary to render the claims tangible.

For the purpose of this office action, it is assumed that the platform is

incorporated into the appropriate hardware.

As per claims 33, the claim recites "a computer-readable signal-bearing

medium.." which does not fall within one of five categories of statutory subject matter,

namely, new and useful improvement thereof. When non-functional descriptive material

is recorded on some computer-readable medium, it is not statutory since no requisite

functionality is present to satisfy the practical application requirement. Merely claiming

nonfunctional descriptive material stored in a computer-readable signal-bearing medium does not make statutory.

As per claims 34, the claim recites "....wherein said medium.." which does not fall within one of five categories of statutory subject matter, namely, new and useful improvement thereof. When non-functional descriptive material is recorded on some computer-readable medium, it is not statutory since no requisite functionality is present to satisfy the practical application requirement. Merely claiming nonfunctional descriptive material stored in a computer-readable signal-bearing medium does not make statutory.

As per claim 35, the claim recites "a product of claim 33, wherein said medium is modulated carrier signal" does not fall within one of five categories of statutory subject matter, namely, new and useful improvement thereof. When non-functional descriptive material is recorded on some computer-readable medium, it is not statutory since no requisite functionality is present to satisfy the practical application requirement. Merely claiming nonfunctional descriptive material stored in a computer-readable signal-bearing medium does not make statutory.

As per claim 36, the claim recites "...of claim 35, wherein said SIGNAL is ..." does not fall within one of five categories of statutory subject matter, namely, new and useful improvement thereof. When non-functional descriptive material is recorded on some computer-readable medium, it is not statutory since no requisite functionality is present to satisfy the practical application requirement. Merely claiming nonfunctional

descriptive material stored in a computer-readable signal-bearing medium does not

make statutory.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the
United States before the invention thereof by the applicant for patent, or on an international application
by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this
title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act

of 1999 (AIPA) and the Intellectual Property and High Technology Technical

Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting

directly or indirectly from an international application filed before November 29, 2000.

Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior

to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 1-37 are rejected under 35 U.S.C. 102(e) as being anticipated by

Hitchcock et al. U.S. Patent # 6,345,278 (hereinafter Hitchcock).

As per claim 1, Hitchcock teaches a method of selectively displaying a markup

language form element (Fig. 2 element 52 and Fig. 3 element 38) on a Web page (Fig.

2 element 36 and Fig. 3 element 40) when an object is available to a Web server (Fig. 1

element 16), the method comprising the steps of (Fig. 2):

-(a) associating the markup language form element (Fig. 2 element 52 and Fig. 3 element 38) with the object (Fig. 2 element 52 "Create your account" & Fig. 3 element 38 "Apply: Lewis & Clark college") (column 4 lines 23-47);

The reference teaches by clicking on the element to access the object, which is therefore associated.

-(b) determining whether the object is available to the Web server (column 4 lines 23-47) (Fig. 4, 6A);

-(c) generating a markup language document that includes the markup language form element if the object is available to the Web server (Fig. 4 element 54) (Fig. 6a,6b,6c,6d)(column 4 lines 23-47)(column 5 lines 44-67) (column 6 lines 1-11) ; and

-(d) displaying the markup language form element on the Web page if the markup language document contains the markup language form element. (Fig. 4 element 54) (Fig. 6a, 6b, 6c, 6d)(Fig. 9a, 9b, 9c) (Column 4 lines 23-47)

As per claim 2, Hitchcock teaches the method of claim 1, wherein the markup language is HTML (column 4 lines 23-32) (column .5 lines 44-67) (column 6 lines 1-11)

As per claim 3, Hitchcock teaches the method of claim 1, wherein the markup language form element is a button (Fig. 3 element 38).

As per claim 4, Hitchcock teaches the method of claim 1, wherein step (b) includes maintaining a record of whether the object is available to the Web server within a configuration file (column 21 lines 14-39).

The reference teaches the information is stored (maintaining record) on the XML application description file (configuration file).

As per claim 5, Hitchcock teaches the method of claim 4, wherein the configuration file is written in XML. (column 21 lines 14-39).

As per claim 6, Hitchcock teaches the method of claim 1, wherein the object is an application program. (Column 4 lines 23-42) (Column 21 lines 14-39)

As per claim 7, Hitchcock teaches the method of claim 1, wherein step (c) further comprises the step of generating a markup language document that does not include the markup language form element if the object is not available to the Web server. (column 18 lines 59-67) (column 19 lines 1-9)

The reference teaches the engine screens out (does not include) the term (element) already applied for when it return the applications. Therefore it states since the application is already applied and not available to apply again therefore screens out (does not include) it.

As per claim 8, Hitchcock teaches the method of claim 1, wherein step (c) further comprises the step of generating a markup language document that includes a disabled markup language form element if the object is not available to the Web server. (Column 18 lines 59-67) (Column 19 lines 1-9)

The reference teaches the engine screens out (does not include) the term (element) already applied for when it return the applications. Therefore it states since the application is already applied and not available to apply again therefore screening it out because if the application not available it is disable because one cannot access it anyway.

As per claim 9, Hitchcock teaches a computer program comprising means adapted to perform all the steps of claim 1 when said program is run on a networked computer. (Fig. 1 element 14,18,16,28) (Column 3 lines 55-67) (Column 4 lines 1-11, 24-42)

As per claim 10, Hitchcock teaches a computer program as claimed in claim 9 embodied on a computer readable medium. (Fig. 1 element 14,18,16,28) (Column 3 lines 55-67) (Column 4 lines 1-11, 24-42)

As per claims 11-18, they teach same limitations as claims 1-8 respectively, therefore rejected under same basis.

As per claims 19-27, they teach same limitations as claims 1-8 respectively, therefore rejected under same basis.

As per claims 28, Hitchcock teaches a computer system for selectively displaying a markup language form element on a Web page when an associated object is available to a Web server, said computer system comprising:

-(a) a server for generating a markup language document (column 3 lines 65-67)(column 4 lines 1-11 lines 23-41), said server comprising:

(i) storage (Fig. 1 element 26) means for storing a value representing whether the object is available to the Web server (column 21 lines 13-29);

(ii) a first processing means coupled to said storage means for:

(A) determining whether the object is available to the Web server determining whether the object is available to the Web server (column 4 lines 23-47) (Fig. 4, 6A);

(B) generating a markup language document that includes the

markup language form element if the object is available to the Web

server (Fig. 4 element 54) (Fig. 6a,6b,6c,6d)(column 4 lines 23-

47)(column 5 lines 44-67) (column 6 lines 1-11);

-(b) a communications network (Fig. 1 element 18) coupled to said server (Fig. 1

element 16); and

-(c) a second processing (Fig. 1 element 14,28) means coupled to said server

through said communications network, said second processing means for reading and

displaying the markup language document (column 3 lines 55-67)(column 4 lines 1-53).

As per claims 29-30, they teach same limitations as claims 2-3 respectively,

therefore rejected under same basis.

As per claims 31-32, they teach same limitations as claims 7-8 respectively,

therefore rejected under same basis.

As per claim 33,35-36, they teach same limitations as claims 1-10, therefore

rejected under same basis.

As per claim 34, Hitchcock teaches the product of claim 33, wherein said medium

is a recordable data storage medium (Fig. 1 element 24,26).

As per claim 37, Hitchcock teaches the product of claim 36 wherein said network

is the Internet (Fig. 1 element 18).

Conclusion

4. The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure.

A) "Universal Forms Engine" by Hitchcock et al. U.S. Patent # 6,345,278

B) "Web Server with integrated scheduling and Calendaring" by Haverstock et al.

U.S. Patent # 6,064,977

5. A shortened statutory period for response to this action is set to expire **3 (three)**

months and 0 (zero) days from the mail date of this letter. Failure to respond within

the period for response will result in **ABANDONMENT** of the applicant (see 35 U.S.C

133, M.P.E.P 710.02, 710.02(b)).

6.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Dhairya A Patel whose telephone number is (571) 272-

4066. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Zarni Maung can be reached on (571) 272-3939. The fax phone number for

the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

ZARNI MAUNG
SUPERVISORY PATENT EXAMINER